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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,656	11/30/2004	Olaf Schafer	04-630	8768

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SUITE 1201
NEW HAVEN, CT 06510

EXAMINER

FARAH, AHMED M

ART UNIT	PAPER NUMBER
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3769

MAIL DATE	DELIVERY MODE
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02/13/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/516,656

Applicant(s)

SCHAFER, OLAF

Examiner

Ahmed M. Farah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Note: the applicant's representative suggested/requested telephone interview to resolve the any outstanding issues after considering the amendment to the claims in order to place the application in condition for allowance. In response to the applicant's requests, the Examiner attempted to reach the applicant's representative prior to this Office Action but could not reach him in time.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 35, and dependent claims 26-34 thereof, are again rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claim 35 recite the first and second laser modules are disposed in the handpiece.

In contrary to this claimed limitation, paragraph [0013] of the instant application states that the handpiece is preferably "connected in a releasable manner to a rear part which in turn communicates with a base unit via a common line," and the laser modules, the associated power circuitry and control modules are housed together in this base unit. Furthermore, Figure 1 shows the laser modules 2,3, are housed in the base unit 1;

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and Figure 2 shows the handpiece is optically connected to the base unit, but does not house the laser modules.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-24 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Rizioi et al. US Patent No. 6,350,123 in view of Irwin US Patent No. 7,144,248.

Rizioi et al. disclose a medical apparatus for dental treatment, the apparatus comprising a handpiece, a light guide in the handpiece, and first and second laser modules having different wavelengths as presently claimed (see Fig. 1). The apparatus of Rizioi et al. further comprises at least one lens, a cooling fluid, a coolant line, and a light delivery means such as optical fibers and hollow waveguides.

With respect to the recitation that the instrument comprises "a plurality of differently constructed handpieces" in claim 18 as amended, Rizioi et al. teach that the handpiece may be any of a plurality of differently constructed handpieces (see Figs. 5a, 5b, and col. 6, lines 3-9). Moreover, the court held that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced, see *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

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Although Rizoïu et al. employ at least two different lasers, they do not teach the use of a diode laser and/or an Er:YAG lasers as claimed. They further fail to teach the use of two lenses. However, the Examiner again takes a note that the use of diode and/or Er:YAG lasers to provide treatment energy is well known in the medical art. Moreover, the use of multiple lenses to direct optical energy to a desired location is also known in the art.

Irwin teaches an alternative treatment device comprising a diode laser for providing treatment energy, a delivery handpiece, and at least two lenses for directing the treatment light. Hence, at the time of the applicant's invention, it would have been obvious to one skilled in the art to modify Rizoïu et al. in view of Irwin and use a diode laser as an equivalent alternative light source to provide treatment energy. It would have been further obvious to one skilled in the art to use multiple lenses to direct the treatment energy.

With respect to the recitation in claim 18 as amended that the first laser module and the second laser module are disposed in "base unit [that] communicates with the rear part via a common line," the court decided that "that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice." See *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965).

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ahmed M. Farah whose telephone number is (571) 272-4765. The examiner can normally be reached on Mon, Tue, Thur and Fri between 9:30 AM 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johnson Henry can be reached on (571) 272-4768. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system; call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ahmed M Farah/
Primary Examiner, Art Unit 3769

November 10, 2008.